

### **REMARKS**

Claims 32-38, 41, 43-45, 48, 50-56, 58-61, 63-66 and 68-73 are pending in the application. In the Office Action, the Examiner rejected claims 32-38, and 64, 65 under 35 U.S.C. §112, second paragraph. Claims 32-38, 41, 43-45, 48, 50, 64, 65, 68 and 69 are rejected under 35 U.S.C. §102. A non-statutory double patenting rejection is set forth, and a provisional non-statutory double patenting rejection is set forth. The specification is objected to. The drawings are objected to.

By this paper, Applicants have addressed all the objections and rejections set forth by the Examiner in the Office Action, and included amendments that cancel claims and adopt examiner suggestions, in order to place the application in condition for allowance. Without conceding that the Examiner has set forth a *prima facie* case of indefiniteness and/or anticipation for each claim, independent claims 32 and 41 and their dependents have been canceled. A terminal disclaimer is submitted herewith to address the non-statutory double patenting rejection. Replacement drawing sheets are submitted herewith. An amendment to the specification is presented herein. Applicants reserve the right to pursue the subject matter of the canceled claims in a Request for Continuation in the instant application, or in a continuing application.

For at least the following reasons, claims 51-52, 54-56, 58, 60-61, 63 and 70-73 are believed to be in a condition for allowance.

### **OBJECTION TO THE DRAWINGS**

The drawings are objected to for not including reference signs mentioned in the description. Amended drawing sheets are submitted herewith, which include amendments to Figures 25 and 29.

### **OBJECTION TO THE SPECIFICATION**

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, specifically for the terms first bearing surface, second bearing surface, third bearing surface, fourth bearing surface, angled section, first straight section, second straight section, first convexly curved section, and second convexly curved section.

Regarding the terms 'first bearing surface', 'second bearing surface', 'third bearing surface', and 'fourth bearing surface', the specification has been amended to set forth those terms, in accordance with MPEP 2163.06. This amendment does not constitute new matter, as the bearing surfaces are already disclosed in at least Figures 25-29. Bearing surfaces are also disclosed in the general context of the invention in paragraphs [0033] and [0091].

Regarding the term 'angled section', all claims including that term are herein canceled.

Regarding the term 'first straight section', paragraph [0122] of the specification has also been amended to include the term 'straight section'. Support for this amendment is found on p. 13, last paragraph of the previous Reply to Office Action date April 6, 2011, and in paragraph [0122] of the specification.

Regarding the term 'second straight section', the specification and Figure 29 have been amended to point out this feature. Support for these amendments is found in Figure 29, in which a dashed line lying between arms 165 and 167 shows a straight section of the bearing surface, the dashed line included in the original disclosure.

Regarding the terms 'first convexly curved section' and 'second convexly curved section', the specification in paragraph [00122] has been amended to add the word 'convexly'. Support for this amendment is found in at least Figures 25 and 26, in which it can be seen that curved sections 152 and 154 are convexly curved.

All of the objections to the specification raised in the Office Action have been addressed as set forth above, and withdrawal of the objection is requested.

#### DOUBLE PATENTING

Submitted herewith is a properly executed terminal disclaimer, in which the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of prior patent no. 7,927,374 is disclaimed.

Applicants note the provisional nonstatutory double patenting rejection of claims 32-38, 41, 43-45, 48, 50-56, 58-61, 63-66 and 68-73 as being unpatentable over all claims of copending application nos. 12/241,326, 11/534,014 and 12/041,910. At such time as claims in either application are patented, the rejection will be addressed.

Applicants respectfully disagree with the provisional nonstatutory double patenting rejection of all claims over all claims of copending Application no. 12/041,910. In the Office Action p. 4, the Examiner mis-stated ‘Applicant has elected to prosecute the same species in all cases’, namely 12/241,326, 11/534,014 and 12/041,910. However, in application no. 12/041,910, Applicants have not elected to prosecute the same species as in the present application. Instead, in the response dated June 10, 2011 to a Requirement for Election/Restriction dated May 11, 2011, Applicants elected to prosecute Claims 18-40, which are drawn to a method of replacing a natural joint. This invention is distinct from the invention of the present application, because, as set forth on p. 2 of the Requirement for Election/Restriction, the process for using the product as claimed can be practiced with another materially different product. In the instant case the intervertebral disc prosthesis can be used as an *ex vivo* teaching model. Additionally, the in application 12/041,910 Applicants further elected Species 1: A method of replacing a natural joint using a two component prosthesis. The elected species in the instant case includes a three component prosthesis. Applicants respectfully request withdrawal of the provisional nonstatutory double patenting rejection over copending application no. 12/041,910.

#### CLAIM REJECTIONS – 35 U.S.C. §112

Claims 32-38, 64 and 65 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. By this paper, claims 32-38, 64 and 65 have been canceled, rendering the rejection moot.

#### CLAIM REJECTIONS – 35 U.S.C. §102

Claims 32-38, 64 and 65 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Published Patent Application No. 2006/0116768 to Krueger et al. By this paper, claims 32-38, 64 and 65 have been canceled, rendering the rejection moot.

Claims 32-38, 41, 43-45, 48, 50, 68 and 69 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 7,850,733 to Baynham et al. By this paper, claims 32-38, 41, 43-45, 48, 50, 68 and 69 have been canceled, rendering the rejection moot.

### **CONCLUSION**

By this paper, Applicants have made an earnest attempt to place this case in condition for allowance, by canceling claims and adopting suggestions made by the Examiner. Other than as explicitly set forth above, this reply does not include acquiescence to statements, assertions, assumptions, conclusions, or any combination thereof in the Office Action. For the foregoing reasons and for other reasons clearly apparent, Applicants assert that claims 51-52, 54-56, 58, 60-61, 63 and 70-73 are in condition for allowance. If there are any remaining issues preventing mailing of a Notice of Allowance, the Examiner is respectfully requested to contact the undersigned.

Dated this 15<sup>th</sup> day of August 2011.

Respectfully submitted,

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